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10/659,465	09/10/2003	Edward J. Stashluk JR.	067439.0141	5518
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BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			RUHL, DENNIS WILLIAM	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/659,465	Applicant(s) STASHLUK ET AL.	
	Examiner Dennis Ruhl	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/29/08; 2/10/09; 3/9/09</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's response of 12/29/08 has been entered. The examiner will address applicant's remarks at the end of this office action.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-6,8-11,13-27, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to the claims, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter. The only tie or use of a machine (not a particular machine, just a computer system in a generic sense) is for the providing of return labels or providing a notification. These are limitations directed to insignificant extra solution activities and does not constitute a sufficient tie. With respect to the use of a carrier service and the transporting of the package, this is not tied to any particular machine. It is also noted that there is no transformation occurring in the claim scope. Neither of the two requirements is met by the claim; therefore it is not considered to be statutory. The

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dependent claims do not remedy the situation and are not tied to a particular machine or act to transform eligible subject matter from one state to another.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 1,20, it is not clear as to what is meant by reciting that the package is shipped to the shipping destination using "reverse zone skipping". What is the scope of this language? In the specification on page 4, it is disclosed that with respect to the return label, data on the return label may further ensure that the package is delivered to a point of return close to the customer, thereby providing "reverse zone skipping". This appears to be a term that the applicant has made up that is not a recognized term of art. It is not clear what this term means and what scope it has because the data that relates to the delivery of the package is the shipping destination such as an address, so other than using an address, what does this term require? Does the scope of this term simply mean that "reverse zone skipping" is the shipping of a package to a destination? With respect to "close" to a customer, what does this mean? Close is a relative term and if reverse zone skipping is the act of shipping to a destination that happens to be close to a customer, how close is in the scope of this language and how far would not be? Is 50 miles from a customer close or is within 500 miles close to the customer? The scope of

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this term is not clear and the only mention in the specification does not seem to sufficiently define this term so that its scope is known. Also, the language of "as the shipping destination is athe returns provider" is considered to be indefinite. What is meant by "as the shipping destination is". This language is not clear and renders the claim indefinite.

For claim 10, it is not clear as to what is meant by reciting that "data" is electrical circuitry. Data is data, and data cannot be considered as electrical circuitry to a reasonable person. How can data, which is information representative of something (numbers, text, figures, etc.), be electrical circuitry? This does not seem to make any sense.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5,7,9-11,14-21,23,26, are rejected under 35 U.S.C. 102(e) as being anticipated by Hauser et al. (6536659).

For claims 1,3,20,21,23, Hauser discloses a method and system for enabling the return of products by sending a return to a return center (service provider). A customer is provided with a bar coded return label as claimed. See column 3, line 43 to column 4,

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line 35. The return label may be provided to the customer via computers and is received in electronic form by the customer for printing. The destination address is on the label as claimed. The label has bar coded data that is relevant to the return of the merchandise (identification of the transaction) and includes the merchant identification. Also, with respect to reciting what the data is that is on the label, unless the data is somehow used in a further method step of the claim in a functional manner, this is directed to non-functional descriptive material (in a similar sense to a printed matter issue for a return label as an article). The claim will not be rendered patentable by the mere recitation to non-functional descriptive material. With respect to the newly added language to the claim that recites the package is shipped to the shipping destination using "reverse zone skipping", the scope of the claim is specifically reciting that the package is shipped to the destination, so this satisfies what is claimed as this is best understood by the examiner. In Hauser a shipping service is used to send the package to a destination and the newly added language does not appear to recite or require anything more than the shipping of the package to a destination. The language reciting that the shipping destination is a "carrier center" that also happens to be "near a return center", is noted but does not distinguish over Hauser. In Hauser, whatever the destination is called or considered, it satisfies the claimed "carrier center". A destination is a destination, and simply calling it by a certain name (carrier center versus a return center disclosed by Hauser) does not change the fact that the package is being shipped to a destination. With respect to the language reciting that the destination is near a returns center, this language is directed to non-functional descriptive material. This is

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just descriptive language that has not practical limiting affect on the claim scope. One could also claim that the destination is near a library and that would still not change the fact that the package is just being claimed as being shipped to a destination. What that destination is close to or near does not receive patentable weight because it is language directed to non-functional descriptive material. The language that recites the package is received "for transportation to the return center" is noted as being language directed to the intended purpose of the receiving step. All that is claimed in the last two lines of the claim is that the package is received, which is found in Hauser. This satisfies what is claimed.

For claim 20, the recitation regarding the notification is directed to non-functional descriptive material. Unless the notification is acted upon in a further method step it will not serve as a limitation. Also in Hauser it is disclosed that the return label and the return can be pre-authorized.

For claim 2, this claim is directed to non-functional descriptive material. Reciting the name of the return provider is just descriptive language that does not serve as a further structural limitation.

For claim 4, as this claim is best understood by the examiner, the address on the return label complies with the USPS specifications; otherwise, the packages would never be able to be mailed.

For claim 5, see column 2, lines 17-23 where the claimed limitation is disclosed.

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For claim 7, Hauser discloses that the return label can be received via email or via the Internet. See column 4, lines 30-35 and/or column 4, lines 1-15. When using email to receive a return label, this is using the Internet as claimed.

For claim 9, see column 4, lines 16-35.

For claim 10, claiming that the data is electrical circuitry and that the data is an RFID tag is indefinite and it is not know what the scope of this claim is. Data is data and Hauser discloses data on the return label. To this extent Hauser satisfies what is claimed.

For claims 11,14-19, this claim is directed to non-functional descriptive material. Also, with respect to reciting what the data is that is on the label, unless the data is somehow used in a further method step of the claim in a functional manner, this is directed to non-functional descriptive material (in a similar sense to a printed matter issue for a return label as an article). The claim will not be rendered patentable by the mere recitation to non-functional descriptive material.

For claim 26, reciting that the carrier station is a "regional bulk mail center" does not change the fact that the package is shipped to a destination, which is disclosed by Hauser. What you call or name the destination does not distinguish over Hauser. In Hauser the return destination is a location of some kind and can fairly be considered a carrier station and/or a bulk mail center. The destination can also be considered as a building, a structure, a return facility, etc., in other words, what you call the destination does not change the fact that all that is recited is a destination. Hauser satisfies what is claimed.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 6,8,22,24,27, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser et al. (6536659).

For claim 6, not disclosed is that the return label is attached to an invoice. Hauser discloses that the return label can be included with the merchandise when it is initially purchased, see column 2. The minor difference of reciting that the return label is attached to an invoice is considered to be obvious to one of ordinary skill in the art. One of ordinary skill in the art would understand that the return label could simply be placed in the container that the merchandise is sold in, or can be attached to an invoice that would be included with the merchandise. It would have been obvious to one of

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ordinary skill in the art at the time the invention was made to attach the return label to an invoice. This involves no more than ordinary skill in the art.

For claims 8,22,27, not disclosed is the use of the postal code, and the assessing of shipping charges. The examiner again takes "official notice" of the fact that it is known in the art of shipping packages that an item can be shipped and after shipping has occurred, the shipping charges are assessed. This is known in the art as "reverse manifesting", where the shipping charges are assessed after the package has been received at its destination. Applicant has not challenged this official notice so the asserted fact is now taken as fact for the record. It would have been obvious to one of ordinary skill in the art at the time the invention was made to assess shipping charges as claimed by using "reverse manifesting" and assessing the charges once the package is at its destination. With respect to the use of a postal code to assess the shipping charges, this is just using the zip code of a return address. This is very well known in the art and one of ordinary skill in the art would have found it obvious to use a postal code (e.g. zip code) to assess shipping charges. The origin zip code can be used to identify where the package originated from, and the destination zip code can be used to figure out where it was shipped to, then the shipping can be determined.

For claim 24, the machine readable data is used to determine if the merchant will accept the return after it has been received at the return center. After this determination is made, at some point it would have been obvious to one of ordinary skill in the art to inform the customer of information regarding the return. This could be as simple as a notification to the customer that the items have been received.

11. Claims 13,25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hauser et al. (6536659) in view of Junger (6085172).

For claims 13,25, not disclosed is that the return provider maintains multiple return centers or that the package is received at a first carrier station (a first destination) prior to being received at the destination (which applicant recites as the carrier center). Junger discloses a merchandise return system that has regional return centers that merchandise is returned and shipped to as opposed to having only one return center for the entire county. See figure 1. Product returns are disclosed as being shipped to a regional location (first carrier center) prior to being shipped to a final destination. See column 3, lines 58-64 as an example. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have multiple regional return centers so that merchandise can be shipped to a regional return center that is closest to the customer for processing prior to being sent to the final destination. This feature is known in the art as evidenced by Junger.

12. Applicant's arguments filed 12/29/08 have been fully considered but they are not persuasive.

With respect to the 101 rejection, the current rejection of record addresses the amended claim scope, which applicant is referred . The only tie or use of a machine (not a particular machine, just a computer system in a generic sense) is for the providing of return labels or providing a notification. This can be the mere transmission

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of the label for printing or the mere sending of a message. These are limitations directed to insignificant extra solution activities and does not constitute a sufficient tie. Also, the mere recitation to a computer in a generic sense is not a particular machine that has been programmed to do anything at all. That is not a tie to a “particular” machine but a tie to a general computing device. The tie to the particular machine must be a tie that involves the central steps to the method and not simply steps that include the mere transmission of data (return label) or the printing of the return label, both in the scope of the providing step that is recited as being done by using a computer.

With respect to the prior art traversal, applicant has argued the newly added limitation of the “reverse zone skipping” limitation in the claims. This has been addressed in the current rejection of record as far as how this language has been treated as well as the fact that this has been found to be indefinite. Hauser discloses the shipping of the package to a destination, which satisfies what is claimed. Claims 25-27, which are newly added, have been addressed in the rejection of record and no further comments are deemed as necessary.

It is noted that for the dependent claims and the 103 rejections of record, the applicant has chosen not to present any arguments. Applicant has argued only independent claims; therefore, the dependent claims stand or fall with the independent claims. With respect to other assertions made by the examiner and/or the taking of “official notice” by the examiner, applicant has not traversed them and this is taken as acquiescence as to the merits of the rejections; otherwise 37 CFR 1.111 obligates applicant to point out “the supposed errors” in the office action. With respect to the

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taking of "official notice", failure to traverse the "official notice" in the next immediate response results in the asserted fact being taken as a matter of fact for the record.

Applicant cannot as a matter of right challenge the taking of "official notice" at a later time of their choosing, it must be traversed in the next immediate response after the official notice was first taken. The asserted fact relating to the taking of official notice is now taken as fact for the record due to a failure by applicant to traverse the assertion.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Ruhl/
Primary Examiner, Art Unit 3689